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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/550,531	07/12/2006	George Telfer	3337.5	3131

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EXAMINER	
HUTCHINS, CATHLEEN R	

ART UNIT	PAPER NUMBER
3672	

NOTIFICATION DATE	DELIVERY MODE
09/30/2008	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

DOCKETING@OSHALIANG.COM

Office Action Summary	Application No.	Applicant(s)	
	10/550,531	TELFER, GEORGE	
	Examiner	Art Unit	
	CATHLEEN R. HUTCHINS	3672	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *06 June 2008*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-13, 15-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-13 and 15-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *22 September 2005* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Baker, US2275939.

Baker teaches a cleaning tool Fig 1 and Fig 2 for use on a work string, the tool comprising a cylindrical body A having an axial bore running there through, a plurality of eccentrically located cleaning elements 15 mounted thereon, the cleaning elements, with substantially rectangular cross-section Fig 2: 15 to provide a first edge 18 between a side and an outer face, the outer faces having a curvature greater than a curvature of the cylindrical body shown in Fig 2 and Fig 3, with a profiled tapered end 30 and a profiled end providing a stop 29, the elements located in at least one band Fig 1 showing elements in one linear band around the circumference of the body, located in a recess 16 of the body, the recess located longitudinally in the body and eccentric Fig 2 shows 16 is eccentric to the axial bore; positioning means 19- a biasing spring located in the recess, and held in compression to bias the element away from the body page 2, column 1: 50-52- to move the cleaning elements in relation to the cylindrical body from a first position to a second position, wherein, in the first position, the outer

faces of the cleaning elements define a cylindrical surface centralized to the axial bore capable of providing a polishing action Fig 2, wherein one position can be aligned to match the curvature of the elements 15, and, in the second position, the outer faces present leading edges providing a scraping action Fig 2 or Fig 3 (and the title, which defines a casing scraper), wherein the edges have a different curvature than the casing, and the faces are located outwardly of the first position. The outer face comprises a material softer or more malleable than the material of a polished bore receptacle wherein the spring 19 is more malleable than a casing or polished bore receptacle, and is part of the outer face. The end comprises a mill 18, so that the tool acts as a top dress mill.

Claims 13, 15, 16, 19, and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Telfer, WO98/35131.

Telfer teaches a method of cleaning a liner top, the method comprising the steps; (a) inserting a cleaning tool into a liner p2: 17-38; (b) running the tool and liner together into a well bore p2:17-38; (c) setting the liner at a casing in the well bore p2:17-38; (d) rotating and/or reciprocating the tool to clean an inner surface of a PBR on the liner with curved outer surfaces 505 (in which portions of 505 are curved to create a scraping edge) of the cleaning elements thereon p24: 23-32; (e) pulling the tool from the PBR, so that the cleaning elements move outwardly to contact neighboring casing at the liner top p2: 27-29, in which the cleaner 500 in Figure 13 is attached to the top of bonnet 252, which is inserted into the BPR 250 as shown in Figure 9A, and described in page 24: 6-7 and 10-12; (f) rotating

and/or reciprocating the tool to clean an inner surface of the neighboring casing with the leading edges of the cleaning elements claim 28; tripping the tool from the wellbore claim 28, wherein raising the tool string equivalent to tripping from the wellbore; attaching the tool to a liner setting tool p24: 23-24, wherein the liner setting arrangement is equivalent to the liner setting tool, so that the tool is tripped out with the setting tool; dressing a top of the polished bore receptacle p1:27-30, wherein removing cement from the top of the liner is equivalent to dressing the top of a polished bore receptacle; setting down weight on the tool to set a packer Fig 4: 56.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 17 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Telfer, in view of Baker.

Regarding claim 17, Telfer teaches all of the elements of claim 13, and a cleaning tool Fig 13 for use on a work string, the tool comprising a cylindrical body 500 having an axial bore running there through, a plurality of cleaning elements 505 mounted thereon, the cleaning elements having outer faces 515, and, positioning means 506 to move the cleaning elements in relation to the cylindrical body from a first position to a second position wherein many different positions may be achieved, wherein, in the first position, the outer faces of the cleaning elements define a cylindrical surface centralized to the axial bore so that the elements provide a polishing action, and, in the second position, the outer faces present leading edges providing a scraping action wherein scraping occurs on 515. Telfer does not teach the cleaning elements being eccentrically located, or the outer faces having a curvature. Baker teaches the cleaning tool of claim 1, with outer faces having a curvature Fig 2. It would have been obvious to a person having ordinary skill in the art of designing scraping tools at the time of the instant invention to modify Telfer in view of Baker, to have eccentrically located cleaning elements with outer faces having a curvature, in order to provide a leading edge to scrape the inner surface of a tube, as taught by Baker in Fig 2.

Regarding claim 18, Telfer teaches all of the method steps of claim 13, but does not specifically teach the step of running the tool back into the polished bore receptacle. However, Telfer does suggest that running the tool back into the polished bore receptacle may be done during the operation of a scraper Abstract: wherein obviating the need to have a separate trip to remove cement from the

liner indicates that a second trip with the scraper is known. It would have been obvious to a person having ordinary skill in the art of designing scraping tools at the time of the instant invention to modify Telfer to add the step of running the tool back into the polished bore receptacle, in order to remove additional cement, which may have not been removed upon the first run of the scraper/ cleaning tool.

Response to Arguments

Applicant's arguments filed 6/6/2008 have been fully considered but they are not persuasive.

Regarding applicant's arguments against the Baker rejection, the examiner refutes these arguments. Baker does teach a controlled position of the blades via springs 19, which work in a similar manner as shown by applicant in Figure 1 with spring 40, thus Baker teaches a scraper that is capable of providing both a scraping and a polishing action depending on the position of the cleaning element. Baker also teaches a cleaning element with a curved surface at both concave portion 18 in Figure 3, and convex portion 15 shown in Figure 2, which is a similar convex curvature as presented by applicant in figure 2 along surface 32.

Regarding applicant's arguments against the Telfer, et al. rejection, the examiner refutes this argument. Telfer, et al. shows that the junk bonnet 252 can be inserted into PBR 250 as shown in Figure 9A, thus applicant's argument that Telfer, et al. does not teach the junk bonnet (and thus the cleaner that is mounted above the junk bonnet) does not enter the PBR, is incorrect. Therefore, Telfer, et al. does teach cleaning the

PBR and reciprocating the tool, in which movement of the tool into the wellbore and PBR for lowering into the wellbore may be considered reciprocation.

Thus all rejections of depending claims are also repeated, and remain valid.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CATHLEEN R. HUTCHINS whose telephone number is (571)270-3651. The examiner can normally be reached on Mon thru Thurs 7:30-5, alternate Fri 7:30-4 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David J. Bagnell can be reached on 571-272-6999. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/CRH/
9/24/2008

/Kenneth Thompson/
Primary Examiner, Art Unit 3672